

Attorney Docket No.: DEX-0113
Inventors: Yang et al.
Serial No.: 09/700,770
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REMARKS

Claims 1, 6 and 7 are pending in the instant application. Claims 1, 6 and 7 have been rejected. Claim 1 has been amended and new claim 8 has been added. Support for these amendments is provided in the specification at pages 7 and 16-28. Reconsideration is respectfully requested in light of these amendments and the following remarks.

Rejection under 35 U.S.C. § 102(e)

Claims 1, 6 and 7 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Bandman et al. (U.S. Patent 6,203,979). The Examiner suggests that Bandman et al. teaches a method of detecting and quantitating a polynucleotide sequence encoding HUPM which is 100% identical to that of SEQ ID NO:3. The Examiner suggests that Bandman et al. teach that detection is accompanied by a comparison with normalized controls at column 35, lines 12-14. Further, the Examiner suggests that Bandman et al. contemplate use of the method for the detection and diagnosis of cell proliferative disorders of the lung at column 34, lines 25-40.

Applicants respectfully traverse this rejection.

U.S. Patent 6,203,979 lists a whole host of potential uses for HUPM at col. 34, lines 25-40 ranging from cell proliferative disorders such as arteriosclerosis to trauma. However, there is no

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enabling support or data for the conjecture that HUPM may be used to detect the presence of lung cancer as required by MPEP §2131.01 to anticipate the instant invention. In fact, there is no data supportive of expression levels of HUPM for any of the diagnostic uses set forth for this nucleic acid sequence. Accordingly, Applicants disagree with the Examiner that the unsupported suggestions of Bandman et al. can anticipate the instant invention.

In an earnest effort to advance the prosecution of this case and to further distinguish the present invention from the conjectures of Bandman et al., Applicants have amended claim 1 to clarify that measured levels in a patient at least two times higher than levels in a control are indicative of lung cancer. Support for this amendment is provided in the specification at page 7 and in data evidencing the utility of these markers as diagnostics for lung cancer presented in the application at pages 12 through 28. Claim 1 has been further amended and new claim 8 has been added to clarify that amino acid sequences encoded by the polynucleotides are also diagnostic markers for lung cancer. Support for this amendment is provided in the specification at pages 3, 6, 19, 24 and 28.

Thus, no new matter is added by these amendments.

Since the teachings of Bandman et al. are silent with respect

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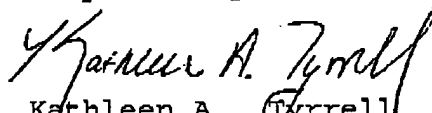
to any expression levels whatsoever which are diagnostic for any of the extensive list of diseases and disorders set forth in this patent, this patent cannot anticipate the claims as amended.

Withdrawal of this rejection under 35 U.S.C. § 102(e) is therefore respectfully requested.

Conclusion

Applicants believe the above-described amendments overcome all rejections of the pending claims and that the foregoing comprises a full and complete response to the Office Action of record. Accordingly, favorable reconsideration and subsequent allowance of the pending claims is earnestly solicited.

Respectfully submitted,



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